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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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SIM & BURNEY
SUITE 701
330 UNIVERSITY AVNEUE
TORONTO, M5G1R7
CANADA

EXAMINER

SCHWADRON, RONALD B

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 12/21/2001

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/007,093

Applicant(s)

Anand et al.

Examiner

Ron Schwadron

Art Unit
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Oct 16, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 5-11, 27, and 28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 5-11, 27, and 28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

18) Interview Summary (PTO-413) Paper No(s). _____

19) Notice of Informal Patent Application (PTO-152)

20) Other: _____

Serial No. 09007093

Art Unit 1644

1. Claims 5-11,27,28 are under consideration. Claims 1-4 have been canceled. Claims 5,6,8,27 have been amended.

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because of the following reasons.

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c). Non-initialed changes have been made to the name of Inventor Cates.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-11, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barber (US Patent #4,950,480), in view of Baier et al. (*J. Virol.* 69(4):2357-2365, 1995) for the reasons elaborated in paragraph 18 of the Office Action mailed 1/6/2000.

The declaration filed on 7/3/2000 under 37 CFR 1.131 has been reconsidered and is ineffective to overcome the cited references. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the cited references.

Regarding the declaration under 37 CFR 1.131 filed 7/3/2000, said declaration does not disclose the country wherein the experiments disclosed were performed.

37 CFR 1.131 states:

Prior invention may not be established under this section in any country other than the United States, a NAFTA country, or a WTO member country. Prior invention may not be established under this section before December 8, 1993, in a NAFTA country other than the United States, or before January 1, 1996, in a WTO member country other than a NAFTA country.

The declaration indicates that the disclosed experiments were performed prior to 4/1995. However, the last two pages of the declaration disclose experiments performed 6/1995 (see bottom

right). The experiments disclosed in said declaration were performed in part by noninventors (numerous pages signed with a signature that appears to be "J. Remar" and another signature that does not appear to be that of an inventor). Applicant needs to address the role of the aforementioned individuals in the claimed invention.

The invention of claim 10 is not disclosed in said declaration.

5. Claims 5-11, 27 and 28 are rejected under 35 U.S.C. 102(b) as being unpatentable over Barber (US Patent #5,194,254) in view of Baier et al. (*J. Virol.* 69(4):2357-2365, 1995) for the reasons elaborated in paragraph 21 of the Office Action mailed 1/6/2000.

Regarding the declaration under 37 CFR 1.131 filed 7/3/2000, see paragraph 4 of this Office Action.

6. Claims 5-11, 27 and 28 are rejected under 35 U.S.C. § 102(a) as being unpatentable over Baier et al. (*J. Virol.* 69(4):2357-2365, 1995) for the reasons elaborated in paragraph 24 of the Office Action mailed 1/6/2000.

Regarding the declaration under 37 CFR 1.131 filed 7/3/2000, see paragraph 4 of this Office Action.

7. No claim is allowed.

8. Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers should be faxed to Group 1600 at (703) 305-3014.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Ron Schwadron whose telephone number is (703) 308-4680. The examiner can normally be reached Monday through Thursday from 7:30 to 6:00. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Serial No. 09007093

4

Art Unit 1644



RONALD B. SCHWADRON
PRIMARY EXAMINER
GROUP 1800 1644

Ron Schwadron, Ph.D.

Primary Examiner

Art Unit 1644

December 20, 2001